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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,017	11/22/2000	Winnie C. Durbin	GEMS8081.023	5745

27061 7590 02/23/2010
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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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3621

NOTIFICATION DATE	DELIVERY MODE
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02/23/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/681,017	Applicant(s) DURBIN ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-23,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-23,25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20100210 for reference purposes only.
2. This Office Action is in response to the Response to Non-Final Office Action, filed by Applicants on 20 October 2009.
3. All references to the capitalized version of “Applicant” refer specifically to the Applicants of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 1, 4-23, 25, and 26 are pending.
5. Claims 1, 4-23, 25, and 26 have been examined.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 8, 12-14, 16, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 8 recites “by one of FTP and email to a field engineer”. A person having ordinary skill in the art would not understand whether the “to a field engineer” applies to the “FTP” portion of the sentence or not; i.e. a person having ordinary skill in the art would not understand whether Applicants are claiming the sending of a file to a field engineer over FTP.

9. Claims 12-14, 16, and 17 recite “the computer”. However, as claim 10 recites a computer (line 3), and claim 11 recites another computer (line 1), it would be unclear which “computer” these claims are referring to. The claims are rendered indefinite because a person having ordinary skill in the art would not understand which “computer” is being referred to.

10. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though claims may be indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 4-7, 10, 15, 23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,956,505 (“Manduley”) in view of U.S. Patent 6,402,737 (“Tajima”).

13. As per claim 1, Manduley discloses:

14. receiving an option-enabling request (figure 4-A, reference 206) from the user specifying an option requested to be enabled (column 7, lines 61-64 - “received request code in order to [determine] what...features are requested to be activated”) in equipment at a subscribing station (figure 1, reference 20);

15. at the centralized facility (column 6, lines 51-53 - “data center”), confirming that the option has not already been enabled (column 8, lines 2-5 - “data center checks to see whether the request code included a request to activate a feature or program that...was already activated”);

16. generating an enabling feature at the centralized facility (figure 4-B, reference 224) upon confirmation that the option has not already been enabled (column 8, lines 6-13 - “Otherwise, step 216 follows step 212”), the enabling feature comprising a software key (figure 4-B, reference 224) designed to enable software already installed in the equipment (column 2, lines 35-40 - “storing in the memory a number of applications...at least one of them applications programs including at least one optional feature”);

17. sending the enabling feature from the centralized facility to the equipment in the subscribing station (figure 4-B, reference 228);

18. activating the option in the equipment (column 2, lines 59-60 - “operating the requested feature if the requested feature was determined to be activated”).

19. Manduley does not explicitly disclose:

20. receiving a user ID at a centralized facility from a user.

21. Tajima teaches:

22. receiving a user ID (figure 6, reference 601) at a centralized facility (figure 1, reference 127) from a user (figure 1, reference 114).

23. Tajima teaches authenticating a user against a database (figure 1, reference 127) in order to create a more secure system. By preventing unauthorized users from operating medical equipment, “an error in view of software of transmitting erroneous operational procedure description to the devices can be prevented” (column 2, lines 59-61). This creates a system where only authorized users are allowed to operate the machinery, thereby reducing the possibility of surgical/medical errors. This, in turn, would create a more profitable system for its creators, because a person having ordinary skill in the art would understand that users are more likely to purchase and use a system that can prevent surgical and other medical errors.

24. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley the user authentication system as taught by Tajima, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more safe, secure, and profitable system.

25. Claims 10 and 23 are substantially similar to claim 1, and are similarly rejected.

26. As per claims 4, 5, 15, and 25, Manduley in view of Tajima discloses as above, and further discloses:

27. equipment includes medical imaging scanners (Tajima, figure 1, reference 117);

28. designing a software key to enable the option for a predetermined trial period (column 7, lines 10-14 - “temporary activation allows a user to have use of a feature on a rental or free trial basis”).

29. As per claims 6, 7, and 26, Manduley in view of Tajima discloses as above, and further discloses:

30. authenticating the user ID after receiving it at the centralized facility (Tajima, reference 604);

31. downloading the enabling feature to the equipment and remotely enabling the feature automatically and without further user input (column 2, lines 59-60 - “operating the requested feature if the requested feature was determined to be activated”).

32. Claims 7 and 26 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley in view of Tajima¹.

33. It is the Examiner’s primary position that the claims are anticipated because the above-mentioned features (i.e. “remotely enabling the feature automatically”) are inherent. However, it would have been obvious to a person having ordinary skill in the art to provide an automatic mechanism for performing this same task. See MPEP §2144.04(III) and *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958): “broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to

¹ MPEP §2112.III authorizes a secondary 35 USC §103 rejection, when the “the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the

distinguish over the prior art". This would also create a more profitable system; a system that operates more quickly also is more likely to be purchased and used by a customer, because users are more likely to buy a faster-operating system due to the efficiency involved.

34. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley and Tajima an automatic means for enabling a feature, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a faster and more profitable system.

35. Claims 8, 9, 11-14, 16, 17, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley in view of Tajima, further in view of Official Notice.

36. As per claims 11, 12, and 18, Manduley in view of Tajima discloses as above, but does not explicitly disclose:

37. receive a system ID and validate the system ID;

38. generate an option key specific to the system ID.

39. The Examiner takes Official Notice that receiving and validating a system ID, as well as generating a key specific to a system ID, were old and well-known in the art because they create a more secure system, whereby only authorized units are able to utilize specific software. By preventing an unauthorized unit (i.e. a unit whose system ID is not valid) from accessing

reference". A second §103 rejection has been made to avoid any potential questions of inherency.

proprietary software, the system is more secure; this leads to a more profitable system, because users are more likely to purchase and use a more secure system

40. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley and Tajima the usage of authenticated system IDs, as well as option keys generated specifically for a system ID, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more secure and profitable system.

41. As per claims 8 and 16, Manduley in view of Tajima discloses as above, but does not explicitly disclose:

42. sending enabling feature by email to a field engineer for manual installation and enablement.

43. The Examiner takes Official Notice that sending information via email, and activating via email was old and well-known in the art because it creates a system that is more reliable and quick than postal mail. Rather than send enabling information via postal mail (which can take weeks to be received, and is costly to confirm receipt), it was well-known to those skilled in the art at the time of the invention to send enabling information via email; a user can be sent the enabling information immediately and confirm it with the distributor immediately (e.g. via a phone call, or an email reply). This, in turn, creates a more profitable system, because users are more likely to purchase and use a system that operates in a faster manner.

44. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley and Tajima the concept of emailing enabling information since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a faster-operating as well as more profitable system.

45. As per claim 9, Manduley in view of Tajima discloses as above, but does not explicitly disclose:

46. sending a verification email to the user confirming option enablement.

47. The Examiner takes Official Notice that sending option confirmation information via email was old and well-known in the art because it creates a system that is more reliable and quick than postal mail. Rather than send confirmation information via postal mail (which can take weeks to be received, and is costly to confirm receipt), it was well-known to those skilled in the art at the time of the invention to send enabling information via email; a user can be sent the confirmation information immediately and confirm it with the distributor immediately (e.g. via a phone call, or an email reply). This creates a more reliable system, because users will possess a copy of information that proves that their software was enabled. This, in turn, creates a more profitable system, because users are more likely to purchase and use a system that operates in a faster manner.

48. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley and Tajima the concept of emailing confirmation information since the

claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a faster-operating, more reliable, and more profitable system.

49. As per claims 13 and 14, Manduley in view of Tajima, further in view of Official Notice, discloses as above, and further discloses:

50. computer is further programmed to send an electronic verification of the option enablement (column 8, lines 47-51 - “confirmation code...to be transmitted to the data center”).

51. As per claim 17 and 19, Manduley in view of Tajima, further in view of Official Notice, discloses as above, and further discloses:

52. option key with a disablement feature to disable the option after a predetermined time period (“temporary activation allows a user to have use of a feature on a rental or free trial basis”).

Claim Interpretation

53. The Examiner finds that because all examined claims (*i.e.* claims 1, 4-23, 25, and 26) recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because all examined claims fail Prong (A) as set forth in MPEP §2181 I., the

Examiner concludes that all examined claims do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

54. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

55. **Ability**: “possession of the qualities required to do something; necessary skill, competence, or power...” Collins English Dictionary, HarperCollins Publishers, London, UK, 2000.

56. **Capable**: “having ability, especially in many different fields; competent.” Collins English Dictionary, HarperCollins Publishers, London, UK, 2000.

57. **Device**: “A generic term for a computer subsystem.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

58. **Design**: “an end aimed at or planned for; intention; purpose.” Collins English Dictionary, HarperCollins Publishers, London, UK, 2000.

59. **Enable**: “to make possible.” Collins English Dictionary, HarperCollins Publishers, London, UK, 2000.

60. **For**: “1 a -- used as a function word to indicate purpose... b -- used as a function word to indicate an intended goal.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

61. ***Generate***: “to produce or bring into being; create.” Collins English Dictionary, HarperCollins Publishers, London, UK, 2000.
62. ***If***: “1 a : in the event that.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A., 1986.
63. ***To***: “2a -- used as a function word to indicate purpose, intention, tendency, result, or end.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

64. Applicant’s arguments, filed 20 October 2009, with respect to the rejection of claims 10-22 under 35 USC §103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection have been made above.
65. Applicants’ arguments with respect to claims 1, 4-7, 8, 9, 23, 25, and 26 have been considered but are moot in view of the new grounds of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

Conclusion

66. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

67. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

68. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621